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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,063	06/22/2005	Peter Geigenberger	13311-00008-US	4909
23416 7590 09/21/2009 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899				
EXAMINER				
PAGE, BRENT T				
ART UNIT		PAPER NUMBER		
1638				
MAIL DATE		DELIVERY MODE		
09/21/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,063

Applicant(s)

GEIGENBERGER ET AL.

Examiner

BRENT PAGE

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45, 47-61 and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45, 47-61 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/31/2009 has been entered.

Claims 45, 47-61 and 63 are pending. The addition of new claim 63 is hereby acknowledged. Claims 45, 47-61 and 63 are examined herein on the merits.

Claim Rejections - 35 USC § 112-1st and 2nd paragraph

Applicant's arguments, see page 5 of response, filed 06/19/2009, with respect to indefiniteness and written description have been fully considered and are persuasive when taken together with the claim amendments. The rejection of claim 61 under 35 USC 112 has been withdrawn.

Claim Rejections - 35 USC § 103

Claims 45 and 47-61 remain rejected and claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harper et al (PGPUB-20020160378) in view of Sowa

et al (1998 PNAS 95:10317-10321) and further, in view of Nykiforuk (US patent 6552250). The claims remain rejected for the reasons of record in the office actions mailed out on 09/08/2006, 10/19/2007, 09/16/2008, 07/08/2009, as well as the reasons set forth below.

Applicant's arguments filed 06/19/2009 have been fully considered but they are not persuasive.

Applicants urge that the previously cited references fail to teach a motivation for altering the invention of Harper et al to produce oil or starch and that the art did not appreciate the property of increased oil and/or starch content (see pages 5-9 of response).

This is not persuasive because the transformation of plants with a hemoglobin gene is taught in the prior art. The only difference between the prior art and the instantly claimed invention is the recovery of oil and/or starch from the resultant transformed plants. As discussed in the prior office action mailed out on 03/31/2009, the plant species taught in the prior art are commonly grown for starch and/or oil isolation and such isolation would have been obvious from the taught, transformed plants based on the standard practice in the art as shown by the Nykiforuk reference. Furthermore, the principle steps in the method claims are all met by the prior art, rendering the method obvious. In the instant case, one of ordinary skill in the art would have been motivated to transform plants with a hemoglobin gene as taught in the prior art. One further would have been motivated to isolate starch and/or oil from maize or potato as these crops are commonly used for oil and/or starch production. If, in the

normal use of plants of the instant invention one would have arrived at the instant invention, the elements would be considered to naturally follow from such normal use and thus render the instantly claimed invention obvious.

No claims are free of the prior art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT PAGE whose telephone number is (571)272-5914. The examiner can normally be reached on Monday-Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571)-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brent T Page

/Anne Marie Grunberg/

Supervisory Patent Examiner, Art Unit 1638